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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,521	07/12/1999	FUMIHIRO MURAMATSU	31879	9839

116 7590 01/16/2003

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EXAMINER

GESESSE, TILAHUN

ART UNIT PAPER NUMBER

2685

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/351,521

Applicant(s)

MURAMATSU ET AL.

Examiner

Tilahun B Gesesse

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1 through 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swail (us 5,630,224).

As per claim 1, Swail discloses a portable information terminal having a built-in radio communication device, (fig 2). Swail discloses a radio communications section (102) for performing transmission and receipt operation through use of a time-division technique, (fig.3). Swail discloses an information section for receiving, processing, storing, and outputting information (105), (fig.2). Swail discloses an interface (117) that electrically connects the radio communication section(102) to the information processing section (105)and exchange information therebetween, (fig.2). Swail discloses a battery(205) for supplying power to the

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radio communications section, the information processing section, and the interface, wherein the portable information terminal (211), (fig.2). Swail discloses means for deactivating the information processing section (105) and the interface (117) when the radio communication section (201 and 203) is in transmission state (col.6 line 60-col.7 line 24 and fig.3). Swail teaching is during the reception cycle, it is considered that similar signaling cycle takes place during the transmission state. It would have been obvious to one of ordinary skill to deactivate the information processing section when built-in radio communication device is in transmission state, in order to conserve power and minimize interference. As to claim 2, Swail discloses means of controlling the radio communication section (103) and the information processing section (215) so as to exchange information while the radio communications section is in a non-transmission state, (fig.2). As to claim 3, Swail discloses everything as explained above and furthermore, Swail discloses the radio communication section has a function of exchanging non-audio data with respect to a network, (col. 1 lines 29-32).

Response to Arguments

4. Applicant's arguments filed 6/24/02 have been fully considered but they are not persuasive for the following reasons.

In paragraph 4 on page 2, of applicant's response, applicant argued that Swail does not teach deactivating an information processing section and interface, which are powered by battery. Nor does the Swail teach deactivating during transmission. The examiner disagrees. Swail discloses a subscriber terminal, which interfaces with a portable computer, during an "active portion" the portable computer is deactivated. During the active portion means the transceiver is either transmitting or receiving

communication is taking place, Further more, it is also inherent that during the deactivate period, portable computer, the interface is also inactive because interface is basically converting signal between two separate modes.

In paragraph 1 on page 3, of response to the office action, applicant argued that the portable computer 105 is not analogous to the information processing section of the claim. The examiner disagrees. In response to applicant's argument that portable computer 105 and information processing section, is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner reads applicant's claim invention in light of the spec. , in this regard, as fig.1 of the invention shows that radio communication section (a2), interface (a3) and information processing section (a4) "computer". Hence, applicant's invention as shown in fig.1 is analogous to Swail fig. 2. and also no specific function is claimed rather than information processing section , the prior art and instant application are deactivated to conserve power. As regard to the battery for supplying power, applicant argued that Swail teach a number of power supply. However, applicant claim does not specify a single power supply used to power the portable information terminal. To sum up, as explained above in response to applicant argument, the prior art "Swail" clearly renders obviousness. Therefore, the rejection is maintained.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Macor (6,463,299) disclose outgoing call (pc in active mode?) no user initiates /continues call with remote unit (fig.4).

Conclusion

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6296, (for formal communications intended for entry)

Or:

*(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")*

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington.
VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun Gesesse whose telephone number is (703) 308-5873.. The examiner can normally be reached on Monday-Friday from 8:00 am to 4:30 pm.

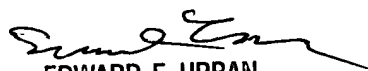
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385. The fax phone number for this Group is (703) 308-6306 or (703) 308-6296.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

TBG

Dec 31,2002

Tilahun Gesesse


EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600